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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re application of:

Michael H. Jander

Serial No.: 09/993,435

Group Art Unit: 1733

Filed: November 20, 2001

Examiner: Samchuan Cua Yao

For: SHEET MOLDING COMPOUND HAVING IMPROVED
SURFACE CHARACTERISTICS

Attorney Docket No.: 24001B

I hereby certify that this correspondence is being sent via facsimile to: Attn: Examiner Samchuan Cua Yao, Mail
Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 fax number (703)
872-9396 on:

7/26/04
(Date of Deposit)

JAN HOSTASA

Jan Hostasa
(Signature)

REPLY

Mail Stop Non-Fee Amendment
Commission for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants acknowledge with appreciation the withdrawal of the
rejection of the claims based upon the Grisch patent set forth in the
Advisory Action dated May 12, 2004. In response to the lone remaining
rejection of the claims based upon a combination of Applicant's admitted

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prior art (APA) with the Stoops et al. or Grisch patents, the Applicants submit herewith a Request for Continued Examination (RCE). After considering the following comments it is believed the Examiner will agree that the claims presently presented in the patent application patentably distinguish over the art and should be allowed.

Turning now to the substantive issues, the Examiner presently rejects claims 1-7 and 26-44 based upon the APA when considered in view of U.S. Patent 4,141,929 to Stoops et al. or U.S. Patent 4,207,282 to Grisch.

It has long been recognized that an Examiner must be careful when considering the scope of Applicant's admitted prior art. In *In re Nomiya, Kohisa, and Matsumura*, 184 USPQ 607 (CCPA 1975), the Court of Customs and Patent Appeals (CCPA) stated "[i]t is necessary to consider everything appellants have said about what is prior art to determine the exact scope of their admission." Quoting *In re Spnonoble*, 160 USPQ 237, 243 (1969), the CCPA stated, "[t]he court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings. . . . The issue, then, is whether the teachings of the prior art would, *in and of themselves and without the benefits of appellant's*

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disclosure, make the invention as a whole, obvious.” (Emphasis in original).

The APA is illustrated in Fig. 1B of the present application. As set forth in the text of the application, the APA includes an upper carrier film layer 12, a top or first resin paste layer 14, a resin impregnated unfilamentized fiber layer 16, a nonfilamentized paste layer 13 and a bottom carrier film layer 20. At page 7 lines 13-14 it is explicitly stated that the layer 13 does not include “filamentized fibers”. This explanation of the admitted prior art cannot be ignored by the Examiner.

While the Examiner acknowledges in the August 28, 2003 Office Action that “[t]he SMC of the APA differs from the SMC recited in claim 1 in that, the APA does not teach using a ‘*resin impregnated filamentized fiber layer*’”, what the Examiner fails to acknowledge is, that means the APA does not disclose a SMC sheet including both (a) a plurality of chopped unfilamentized fibers and (b) a resin impregnated filamentized fiber layer as taught in present independent claim 1. Further, the Examiner fails to explicitly acknowledge that the APA does not disclose a SMC sheet including both (a) a plurality of chopped partially filamentized fibers and (b) a resin impregnated filamentized fiber layer as taught in present independent claim 26. Further, at no point does the APA make any

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suggestion that any advantage would be achieved by producing a SMC sheet with the claimed combination of structures (a) and (b) set forth above. To read such a teaching from the present application into the prior art would be a clear violation of the principles set forth in the *In re Nomiya et al.* decision. Accordingly, the APA provides no motivation whatsoever to one skilled in the art to arrive at the invention as set forth in independent claims 1 and 26.

In the Office Action of August 28, 2003, the Examiner further argues that the Stoops et al. patent teaches "embedding continuous axially aligned filaments to a resin paste layer in forming a sheet molding composition in order to form composite articles having 'excellent parallel flexural strength from the standpoint of strength in a direction normal or perpendicular to the continuous filaments' (abstract; col. 1 lines 7-33; figure 1). . . ." (emphasis added)

However, the fact is the Stoops et al. patent does not teach using the claimed combination of a plurality of chopped unfilamentized fibers and a resin impregnated filamentized fiber layer (see present claim 1) or a plurality of chopped partially filamentized fibers and a resin impregnated filamentized fiber layer (see present claim 26). Importantly, the Stoops et al. patent also fails to recognize that a SMC sheet with the claimed

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combination of structures can be used to mold parts with improved class A type surface characteristics. As such, the Stoops et al. patent clearly does not recognize the benefit derived by the presently claimed structure and also provides no motivation to one skilled in the art to make the proposed modification. It, of course, is well established that "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification" (see *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) and *In Re Laskowski*, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989)). In fact, the only suggestion or motivation for such an approach in the record is the disclosure in the present application. Thus, the proposed rejection must fail.

The Examiner also argues that the Grisch patent discloses "providing a barrier fabric (30) comprising a continuous filament fiberglass mat" in forming an SMC so that the fabric "holds the reinforcing fibers internal to the composite while allowing the resin to pass therethrough to be deposited at the surface of the composite article formed." (emphasis added)

As previously noted the Grisch process is described at column 2 line 40 through column 3 line 25 of the Grisch patent. Specifically that process comprises providing an elastic veil to create a barrier against the fibers. Grisch requires the veil to have grab break strength of at least 10 lbs/inch in

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both longitudinal and transverse directions, a tensile elongation of at least 10%, and a permeability to permit the liquid resin to pass through the veil during molding. Grisch further indicates that a fabric lacking these properties is liable to tear during the molding process. Grisch's examples include nylon, fiberglass, dacron or other thermoplastic material. Significantly, the only glass mats indicated include a continuous filament fiberglass mat and a woven fiberglass mat and neither of these is filamentized. Thus, by the nature of these examples, Grisch actually teaches away from a filamentized layer. As such, even if there exists motivation to combine the APA and Grisch as suggested by the Examiner, the resulting combination differs from and actually teaches away from the presently claimed invention set forth in independent claims 1 and 26.

As pointed out by the Court of Appeals for the Federal Circuit in *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983) and reiterated in *In re Fine*, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988), it is error to find obviousness where references "diverge from and teach away from the invention at hand". Thus, the rejection of independent claims 1 and 26 based upon a combination of the APA and Grisch is clearly improper and should be withdrawn.

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Pending dependent claims 2-7 and 27-31 are equally allowable for the same reason as independent claims 1 and 26.

Independent claim 33 reads upon a single ply of a compacted sheet molding composite sheet comprising an upper carrier film layer, a first resin paste layer, a resin impregnated chopped unfilamentized fiber layer, a resin impregnated filamentized fiber layer and a bottom carrier film layer. Thus, claim 33 reads upon a SMC including the combination of a resin impregnated chopped unfilamentized fiber layer and a resin impregnated filamentized fiber layer in order to provide a sheet from which parts may be molded with improved class A type surface characteristics. As noted above, whether considered alone or in combination, the cited APA, Stoops et al. reference and Grisch reference fail to teach or suggest the claimed structure or provide any motivation whatsoever for one skilled in the art to make a single ply SMC sheet incorporating the structure set forth in claim 33. As such claim 33 should be allowed along with claims 34-38 dependent thereon.

Independent claim 39 reads on a single ply SMC sheet including an upper carrier film layer, a first resin paste layer, a resin impregnated chopped partially filamentized fiber layer, a resin impregnated filamentized fiber layer and a bottom carrier film layer. Once again, the cited prior art

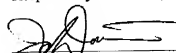
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fails to teach or suggest an SMC having a resin impregnated chopped partially filamentized fiber layer in combination with a resin impregnated filamentized fiber layer. Further whether considered alone or in combination the references fail to provide any motivation whatsoever for one skilled in the art to provide an SMC with the structure set forth in claim 39. Accordingly, claim 39 should be allowed along with claims 40-44 dependent thereon.

In summary, all the pending claims patentably distinguish over the prior art and should be formally allowed. Upon careful review and consideration it is believed the Examiner will agree with this proposition. Accordingly, the early issuance of a formal Notice of Allowance is earnestly solicited.

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The Commissioner is hereby authorized to charge any fees required
to Deposit Account No. 50-0568 in connection with this Reply.

Respectfully submitted,


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Date 7-26-04

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